REMARKS:

Claims 1-29 are currently pending in the application.

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,285,989 to Shoham ("*Shoham*") in view of "Active and Real-time Functionalities for Electronic Brokerage Design", by Beck *et al.* ("*Beck*") and in further view of "Active Database Systems", by Paton *et al.* ("*Paton*").

Although the Applicants believe Claims 1-29 are directed to patentable subject matter without amendment, the Applicants have amended independent claims 1, 5, and 9 and dependent Claims 2, 4, 6, 8, and 18 to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants make no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicants reserve the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-29 stand rejected under 35 U.S.C. § 103(a) over *Shoham* in view of *Beck* and in further view of *Paton*.

Although the Applicants believe Claims 1-29 are directed to patentable subject matter without amendment, the Applicants have amended independent claims 1, 5, and 9 and dependent Claims 2, 4, 6, 8, and 18 to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicants respectfully submit that the ***amendments to independent Claims 1, 30 and 40 have rendered moot the Examiner's rejection of these claims and the***

Examiner's arguments in support of the rejection of these claims. The Applicants further respectfully submit that amended independent Claims 1, 30, and 40 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Shoham*, *Beck*, or *Paton*, either individually or in combination. Thus, the Applicants respectfully traverses the Examiner's obvious rejection of Claims 1-34 under 35 U.S.C. § 103(a) over the proposed combination of *Shoham*, *Beck*, and *Paton*, either individually or in combination.

The Proposed *Shoham-Beck-Paton* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims

For example, with respect to independent Claim 1, this claim recites:

> ***A computer-implemented communications exchange*** using one or more computer systems ***for facilitating communication among a plurality of supply chain participants*** in an electronic marketplace to facilitate one or more marketplace transactions, comprising:
>
> ***a communication interface for sending and receiving messages*** among the plurality of ***supply chain participants*** in the electronic marketplace ***to facilitate one or more marketplace transactions***;
>
> ***an event container*** connected to the communication interface for ***receiving messages from the communication interface as events***, one or more of the messages and their corresponding events each being associated with one or more marketplace transactions;
>
> ***a condition container*** connected to the event container, the condition container ***comprising a plurality of condition instances each specifying one or more rules for determining whether to initiate an action defined by an action instance associated with the condition instance***, a ***particular condition instance*** specifying whether to initiate the action defined in the associated action instance to facilitate one or more marketplace transactions in the electronic marketplace; and
>
> ***an action container*** connected to the condition container and ***containing a plurality of action instances***, each action instance associated with one or more of the condition instances for defining an action to, when initiated, facilitate one or more marketplace transactions in the electronic marketplace;
>
> when one or more events received by the ***event container*** from the communication interface are determined ***to match a predicate of a particular condition instance, the action, defined in the action instance associated with the particular condition instance, is initiated by the communications exchange to facilitate the one or***

more marketplace transactions associated with the one or more events determined to match the predicate of the particular condition instance,

wherein at least one of the ***condition instances*** specifies at least one rule requiring the presence of a specified plurality of specified events in the ***event container*** for initiating a specified one of the action instances in the ***action container***,

wherein ***each event*** is defined to ***expire*** within a respective ***selected time period if unused***, and

wherein each specified ***event is stored in the event container*** only until one of the following occurs:

the condition instance initiating the specified event, or expiration of the specified event. (Emphasis Added).

Independent Claims 5 and 9 recite similar limitations. *Shoham*, *Beck*, or *Paton* fails to disclose each and every limitation of independent Claims 1, 5, and 9.

The Applicants respectfully submit that *Shoham* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a "***computer-implemented communications exchange*** using one or more computer systems ***for facilitating communication among a plurality of supply chain participants*** in an electronic marketplace to facilitate one or more marketplace transactions". In particular, the Examiner equates the "***plurality of supply chain participants***" recited in independent Claim 1 with the "buyers and sellers" disclosed in *Shoham*. (15 November 2006 Office Action, Page 9). (Emphasis Added). In addition, the Examiner asserts that "***an on-line auction is an electronic marketplace***". (15 November 2006 Office Action, Page 9). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. The Examiner further asserts that an "auction is the buying and selling of goods and/or services among buyers and sellers, ***therefore***, the ***buyer and seller are participants in the marketplace***". (15 November 2006 Office Action, Page 9). (Emphasis Added). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion.

The Applicants respectfully request the Examiner to point to the portion or portions of *Shoham*, which expressly state that "***an on-line auction is an electronic marketplace***" and that "the ***buyer and seller are participants in the marketplace***". The Applicants

respectfully submit that the Examiners purported allegation merely presupposes what it concludes. The Applicants further respectfully submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

In contrast, the "***plurality of supply chain participants***" recited in independent Claim 1 are "***participants in an electronic marketplace***" and the "***computer-implemented communications exchange***" facilitates communication among these "***plurality of supply chain participants***" to "***facilitate one or more marketplace transactions***". Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Shoham* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Shoham*.

The Applicants further respectfully submit that *Shoham* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a "***communication interface for sending and receiving messages*** among the plurality of ***supply chain participants*** in the electronic marketplace ***to facilitate one or more marketplace transactions***". In particular, it the Examiner equates the "***communication interface***" recited in independent Claim 1 with a "***notion***" asserted in the Office Action. (15 November 2006 Office Action, Page 10). (Emphasis Added). However, this "***notion***" merely presupposes what it concludes and constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Examiner reasons, that since the system of *Shoham* may operate "on a wide range of hardware", then Figure 4 of *Shoham* supports the "***notion*** wherein there exists a plurality of clients (***traders***) that ***interact*** with a transaction monitor to perform a market operation". (15 November 2006 Office Action, Page 10). (Emphasis Added). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion.

However, "***interface 412***" disclosed in *Shoham* merely provides an interface to a transaction monitor for only receiving requests from ***a client***. (Column 12, Line 38 through Column 13, Line 12). The transaction monitor merely receives the client request and

activates a service. (Column 12, Line 38 through Column 13, Line 12). However, the service is limited to auction services, ***and does not include or is not even related to sending and receiving messages among a plurality of supply chain participants***, as recited in independent Claim 1. (Column 12, Line 38 through Column 13, Line 12).

In contrast, the "***communication interface***" recited in independent Claim 1 "***send[s] and receive[s] messages*** among the plurality of ***supply chain participants*** in the electronic marketplace ***to facilitate one or more marketplace transactions***". Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Shoham* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Shoham*.

The Applicants still further respectfully submit that *Shoham* fails to disclose, teach, or suggest independent Claim 1 limitations regarding an "***event container*** connected to the communication interface for ***receiving messages from the communication interface as events***, one or more of the messages and their corresponding events each being associated with one or more marketplace transactions". In particular, it appears that the Examiner is equating the "***event container***" recited in independent Claim 1 with the "***transaction monitor***" disclosed in *Shoham*. (15 November Office Action, Pages 10-11). However, as mentioned above, the "***transaction monitor***" disclosed in *Shoham* merely receives the client request and activates a service, ***and does not include or is not even related to the event container***, as recited in independent Claim 1. (Column 12, Line 38 through Column 13, Line 12). In contrast, the "***event container***" recited in independent Claim 1 "***receive[s] messages from the communication interface as events***" wherein the "one or more of the messages and their corresponding events each being associated with one or more marketplace transactions". Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Shoham* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Shoham*.

The Applicants yet further respectfully submit that *Shoham* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a "***condition container*** connected to the event container, the condition container ***comprising a plurality of condition instances each specifying one or more rules for determining whether to initiate an action defined by an action instance associated with the condition instance***, a ***particular condition instance*** specifying whether to initiate the action defined in the associated action instance to facilitate one or more marketplace transactions in the electronic marketplace". In particular, it appears that the Examiner is equating the "***condition container***" recited in independent Claim 1 with the "***database***" disclosed in *Shoham*. (15 November 2006 Office Action, Page 11). However, the "***database***" disclosed in *Shoham* is merely a database for storing data related to a general service (always installed) and an installed market specific service, ***and does not include condition instances or is not even related to*** a ***particular condition instance*** specifying whether to initiate the action defined in the associated action instance to facilitate one or more marketplace transactions in the electronic marketplace, as recited in independent Claim 1. (Column 13, Lines 24-54). In contrast, the "***condition container***" recited in independent Claim 1 comprises "***a plurality of condition instances***" wherein each of the condition instances "***specifying one or more rules for determining whether to initiate an action defined by an action instance associated with the condition instance***" and a "***particular condition instance*** specifying whether to initiate the action defined in the associated action instance to facilitate one or more marketplace transactions in the electronic marketplace". Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Shoham* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Shoham*.

The Applicants further respectfully submit that *Shoham* fails to disclose, teach, or suggest independent Claim 1 limitations regarding an "***action container*** connected to the condition container and ***containing a plurality of action instances***, each action instance associated with one or more of the condition instances for defining an action to, when initiated, facilitate one or more marketplace transactions in the electronic marketplace". In particular, it appears that the Examiner is equating the "***action container***" recited in

independent Claim 1 with the "***DLL modules***" disclosed in *Shoham*. (15 November 2006 Office Action, Page 11). However, the "***DLL modules***" disclosed in *Shoham* are merely dynamic link library modules that implement market specific services of the transaction monitor, ***and do not contain a plurality of action instances or any action instances***, as recited in independent Claim 1. (Column 13, Lines 6-23). In contrast, the "***action container***" recited in independent Claim 1 is contains action instances and in particular a "***plurality of action instances***" wherein each of the plurality of action instances is "associated with one or more of the condition instances" associated with the "***condition container***" as discussed above. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Shoham* and independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Shoham*.

The Office Action Acknowledges that *Shoham* Fails to Disclose Various Limitations Recited in Applicants Claims

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Shoham* fails to disclose the emphasized limitations noted above in independent Claim 1. Specifically the Examiner acknowledges that *Shoham* fails to disclose "that the rules include predicates for determining whether they match and the rule requires the presence of a plurality of specified events and the events are stored until the condition is initiated or expiration of the event". (15 November 2006 Office Action, Pages 3-4). However, the Examiner asserts that the cited portions of *Beck* and *Paton* disclose the acknowledged shortcomings in *Shoham*. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Beck* and *Paton*.

The Applicants further respectfully submit that *Beck* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a "***computer-implemented communications exchange*** using one or more computer systems ***for facilitating communication among a plurality of supply chain participants in an electronic***

marketplace to facilitate one or more marketplace transactions" and in particular *Beck* fails to disclose, teach, or suggest independent Claim 1 limitations regarding "when one or more events received by the ***event container*** from the communication interface are determined ***to match a predicate of a particular condition instance, the action, defined in the action instance associated with the particular condition instance, is initiated by the communications exchange to facilitate the one or more marketplace transactions associated with the one or more events determined to match the predicate of the particular condition instance***". *Beck* cannot provide a "***computer-implemented communications exchange***", since Beck fails to disclose, teach, or suggest "when one or more events received by the ***event container***" are determined "***to match a predicate of a particular condition instance***", wherein the "***particular condition instance***" of the "***condition container***" specifies "whether to initiate the action defined in the associated action instance to facilitate one or more marketplace transactions in the electronic marketplace" the "***action***" of the "***action container***" is "***initiated by the communications exchange to facilitate the one or more marketplace transactions associated with the one or more events***" received by the "***event container***" and "***determined to match the predicate of the particular condition instance***".

The Applicants still further respectfully submit that *Beck* or *Paton* fail to disclose, teach, or suggest independent Claim 1 limitations regarding "wherein at least one of the ***condition instances*** specifies at least one rule requiring the presence of a specified plurality of specified events in the ***event container*** for initiating a specified one of the action instances in the ***action container***, wherein ***each event*** is defined to ***expire*** within a respective ***selected time period if unused***, and wherein each specified ***event is stored in the event container*** only until one of the following occurs: the condition instance initiating the specified event, or expiration of the specified event". *Beck* or *Paton* cannot provide a "***computer-implemented communications exchange***", since Beck and *Paton* fail to disclose, teach, or suggest an "***event container*** for initiating a specified one of the action instances" in an "***action container***" wherein "***each event*** is defined to ***expire*** within a respective ***selected time period if unused***" and wherein "each specified ***event is stored in the event container***", since as discussed above, *Beck* or *Paton* does not contain an event container.

The Office Action has Failed to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Shoham-Beck-Paton* Combination

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Shoham*, *Beck*, or *Paton*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious to one skilled in the art at the time of the invention to combine the teachings of *Shoham* with the teachings of *Beck* ***in order to facilitate the use of complex events in e-brokerages***". (15 November 2006 Office Action, Page 5). (Emphasis Added). The Applicants respectfully disagree. In addition, the Office Action further merely states that "it would have been obvious to one of ordinary skill in the art to combine the teachings of *Shoham* with the teachings of *Beck* and *Paton* ***in order to facilitate event detection***". (15 November 2006 Office Action, Page 5). (Emphasis Added). The Applicants respectfully disagree.

The Applicants further respectfully submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Shoham*, *Beck*, or *Paton*, either individually or in combination. Although the Examiner fails to expressly state a motivation for combining the references as proposed, it appears that the Examiner is asserting an implicit motivation to combine the references as proposed in order "***to facilitate the use of complex events in e-brokerages***" and "***to facilitate event detection***". (15 November 2006 Office Action, Page 5). (Emphasis Added). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. For example, how does the ability to "***facilitate the use of complex events in e-brokerages***" or "***event detection***" make it obvious to one of ordinary skill in the art to combine the teachings of *Shoham* with the teachings of *Beck* and *Paton* and to what extent does the Examiner purport that to "***facilitate the use of complex events in e-brokerages***" or "***event detection***" applies to the subject Application. ***The Applicants respectfully request the Examiner to point to the***

portions of Shoham, Beck, or Paton which contain the teaching, suggestion, or motivation to combine these references for the Examiner's stated purported advantage. The Applicants further respectfully submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art***. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Shoham, Beck, or Paton to render obvious the Applicants claimed invention***. The Examiner's conclusory statements that "it would have been obvious to one skilled in the art at the time of the invention to combine the teachings of *Shoham* with the teachings of *Beck* ***in order to facilitate the use of complex events in e-brokerages***" and "it would have been obvious to one of ordinary skill in the art to combine the teachings of *Shoham* with the teachings of *Beck* and *Paton* ***in order to facilitate event detection***", ***does not adequately address the issue of motivation to combine***. (15 November 2006 Office Action, Page 5). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Shoham, Beck, or Paton***, either individually or in combination.

The Applicants Claims are Patentable over the Proposed *Shoham-Beck-Paton* Combination

The Applicants respectfully submit that independent Claim 1 is considered patentably distinguishable over the proposed combination of *Shoham*, *Beck*, and *Paton*. This being the case, independent Claims 5 and 9 are also considered patentably distinguishable over the proposed combination of *Shoham*, *Beck*, and *Paton*, for at least the reasons discussed above in connection with independent claim 1.

Furthermore, with respect to dependent Claims 2-4, 6-8, 10-12, 13-18, 20-23, and 24-29; Claims 2-4 and 13-18 depend from independent Claim 1; Claims 6-8 and 20-23 depend from independent Claim 5; and Claims 10-12 and 24-29 depend from independent Claim 9. As mentioned above, each of independent Claims 1, 5, and 9 are considered patentably distinguishable over *Shoham*, *Beck*, and *Paton*. Thus, dependent Claims 2-4, 6-8, 10-12, 13-18, 20-23, and 24-29 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants respectfully submit that Claims 1-29 are not rendered obvious by the proposed combination of *Shoham*, *Beck*, and *Paton*. The Applicants further respectfully submit that Claims 1-29 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1-29 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-29 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings***. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure***. *In re Vaeck*, 947 F.2d

488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

A Request for Continued Examination (RCE) is being filed in duplicate concurrently herewith to facilitate the processing of this deposit account authorization. **The Commissioner is hereby authorized to charge the $790.00 RCE fee, to Deposit Account No. 500777.**

Although the Applicants believe no additional fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

2/9/07
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